REMARKS

Applicants' attorney thanks the Examiner for her comments and for the courtesy of the telephone interview on 16 November 2004. Independent Claim 21 has been amended to indicate that the breathable, stretch-thinned barrier film has one or more layers, one film layer including a mixture of filler particles and a biodegradable thermoplastic polymer...and constituting 50-100% of a thickness of the film. Independent Claim 50 has been amended to indicate that the breathable, stretch-thinned film has two or more layers, two adjacent film layers each including a mixture of about 5-80% by weight filler particles and about 20-95% by weight of a biodegradable thermoplastic polymer...and together constituting of a 50-100% thickness of the film. Claims 21 and 50 were further amended to recite a Markush group for the biodegradable thermoplastic polymers. Independent Claim 50 was amended to indicate that the breathable barrier film has one to three layers (i.e., not more than three layers).

In the telephone interview, the Examiner asked where the new claim limitations are supported in the specification. Applicants' drawings show a breathable film in which one layer includes a mixture of filler particles and biodegradable polymer and constitutes 50-100% of the film thickness, as recited in Claim 21 (see Figs. 1, 2 and 4). The drawings show a breathable film in which two adjacent film layers include a mixture of filler particles and biodegradable thermoplastic polymer, and together constitute 50-100% of the film thickness, as recited in Claim 50 (see Figs. 2 and 4). The drawings show a breathable film having one to three layers, and including a primary breathable layer, as recited in Claim 53 (see Figs. 1, 2 and 4). Further support for these limitations can be found in the specification, p. 13 lines 16-17 (total film thickness of 10-20 microns), read in conjunction with page 14, line 21- page 15, line 2 (skin layer thickness less than 5 microns, or less than 2.5 microns).

The Markush group Claims 21 and 50 is supported on page 9, line 19 - page 10, line 4 ; page 15, lines 2-8 ; and page 18, lines 2-3.

Additionally, the telephone interview included a discussion of how the new claim limitations better distinguish the invention over the prior art. The differences

discussed in the interview, and other differences, are further elaborated below. The Examiner indicated that she will need to perform another search before deciding whether or not to allow the case.

a) Claim Rejection Based On 35 U.S.C. §112

The rejection of Claim 54 under 35 U.S.C. §112, second paragraph, is respectfully traversed. Claim 54 was amended to recite that the "biodegradable thermoplastic polymers are selected from..." (The Markush group).

b) Claim Rejections Based On 35 U.S.C. §102 (a)

The rejection of Claims 21-22, 24-26, 31, 35-36, 38-42 ,44-49, 53-54 and 56-58 under 35 U.S.C. §102 (a) as anticipated by U.S. Patent 6,261,674 to Branham et al. is respectfully traversed. In order to maintain a rejection based on anticipation, a single reference must disclose every limitation of the rejected claims.

Regarding independent Claim 21, Branham et al. does not disclose a breathable, stretch-thinned barrier film in which one film layer includes a mixture of filler particles and a biodegradable thermoplastic polymer...and constitutes 50-100% of a thickness of the film. The film of Branham et al. has at least 8 layers, preferably at least 60 layers (Col. 5, lines 24-28). As illustrated in Fig. 4 of Branham et al., the disclosed film includes a large number of so-called "microlayers." No single layer dominates the film.

Branham et al. also does not disclose a film in which every layer includes a biodegradable thermoplastic polymer selected from the Markush group in Claim 21. Branham et al. also does not disclose a fibrous nonwoven web including a biodegradable thermoplastic polymer selected from the claimed Markush group. Claims 22, 24-26, 31, 35-36, 38-42 and 44-49 depend from Claim 21, and are patentable for at least the same reasons.

Regarding independent Claim 53, Branham et al does not disclose a breathable barrier film having one to three layers, including a primary breathable layer formed from a mixture of filler particles and a biodegradable thermoplastic polymer. Branham et al. also does not disclose a fibrous nonwoven web including a biodegradable

thermoplastic polymer. The polypropylene webs cited by the Examiner are not biodegradable as defined in Applicants' specification (pp. 3-4). Applicants' specification teaches, but does not claim, the use of non-biodegradable polyolefin spunbond webs (p. 18, lines 3-5). Claims 54 and 56-58 depend from Claim 53, and are patentable for at least the same reasons.

(c) Claim Rejections Based On 35 U.S.C. §103 (a)

The rejection of Claim 23 under 35 U.S.C. §103 (a) as obvious over Branham et al. in view of U.S. Patent 6,050,985 to Lavon et al. is respectfully traversed. Claim 23 depends from Claim 21, and is patentable for at least the same reasons. Lavon et al. does not fill in the gaps in the disclosure of Branham et al., set forth above.

Furthermore, the references teach away from each other, and cannot be properly combined. A suggestion to combine references must be found in the prior art, and cannot be gleaned from Applicants' disclosure or otherwise based on hindsight. In ReVaeck, 947F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991). Branham et al. explicitly requires that the film is formed of microlayers and contains at least 8 layers, preferably at least 60 layers (Col. 5, lines 22-24). Lavon et al does not disclose a structure meeting these requirements. Instead, Lavon et al. focuses on a structural elastic film-like (SELF) web having a rib-like structure as shown in Fig. 5. The SELF web in Lavon et al. cannot be substituted for the mircolayer film structure in Branham et al., or vice versa, because to do so would defeat the objectives of either reference. The references are incompatible, divergent, and cannot be combined.

The rejection of Claims 37, 50-52 and 55 under 35 U.S.C. §103 (a) as obvious over Branham et al. in view of U.S. Patent 6,514,602 to Zhao et al. is respectfully traversed. Claim 37 depend from Claim 21, and is patentable for at least the same reasons. Claim 55 depends from Claim 53, and is patentable for at least the same reason. Zhao et al. does not fill in the gaps in the disclosure of Branham et al., set forth above.

Regarding independent Claim 50, Branham et al. does not disclose a breathable, stretch-thinned barrier film in which two adjacent film layers include a

mixture of about 5-80% by weight filler particles and about 20-95% by weight of a biodegradable thermoplastic polymer...together constituting 50-100% of a thickness of the film. The film of Branham et al. must have at least 8 layers, preferably at least 60 layers (Col. 5, lines 24-28). As illustrated in Fig. 4 of Branham et al., the disclosed film includes a large number of "microlayers." No two adjacent layers dominate the film.

Branham et al. also does not disclose a film in which every layer includes a biodegradable thermoplastic polymer selected from the Markush group in Claim 50. Branham et al. also does not disclose a fibrous nonwoven web including a biodegradable thermoplastic polymer selected from the Markush group.

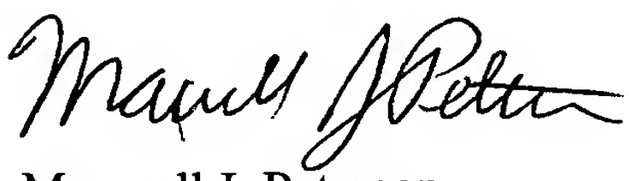
Zhao et al. also does not disclose these limitations of Claim 50. Zhao et al. does not disclose a film in which two adjacent layers include a mixture of filler particles and a biodegradable thermoplastic polymer selected from the claimed Markush group. Zhao et al. does not disclose a fibrous nonwoven web including a biodegradable thermoplastic polymer selected from the Markush group. Claims 51-52 depend from Claim 50, and are patentable for at least the same reasons.

Furthermore, the references teach away from each other, and cannot be properly combined. Branham et al. explicitly requires that the film is formed of microlayers and contains at least 8 layers, preferably at least 60 layers (Col. 5, lines 22-24). Zhao et al. discloses a film having only three layers, including a relatively thick water-soluble layer and a water-permeable layer (Abstract). A primary objective of Branham et al. is to provide a film having a large number of relatively thin layers to facilitate binding and avoid delamination (Col. 5, lines 15-23). A primary objective of Zhao et al. is to provide a film which easily delaminates upon contact with water (due to dissolution of the water-soluble layer) in order to facilitate flushing (Col. 3, lines 34-45). The structure of Braham et al. cannot be substituted for the structure of Zhao et al. or vice versa because to do so would defeat the objectives of either reference. The references are incompatible, divergent, and cannot be combined.

d) Conclusion

Applicants believe that the claims, as now presented, are in condition for allowance.

Respectfully submitted,



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